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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,414	12/27/2001	Christopher Pasqualino	13315US02	1160

23446 7590 03/21/2007  
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CHICAGO, IL 60661

EXAMINER
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PHILIPPE, GIMS S

ART UNIT	PAPER NUMBER
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2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/034,414

Applicant(s)

PASQUALINO, CHRISTOPHER

Examiner

Gims S. Philippe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/28/06</u> <u>12/2/02</u> | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. Applicant's amendment received on December 18, 2006 has been fully considered and entered, but the arguments are not deemed to be persuasive.

***Response to Arguments***

The applicant noted that US Patent Application no. 2002/0186322 to Mair et al. was filed on October 15 2001 and claimed priority to provisional application no. 60/296,075, filed June 8, 2001. The applicant further argues that serial no. 60/296,075 does not properly "support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112 first paragraph.

The examiner respectfully disagrees. The provisional application, while it may appear to the applicant as a paper or proposal. The proposal submitted on the provisional application contains the elements to meet the 35 U.S.C. 112 first criteria.

The provisional application notes in the introduction that The DVI signal perform the encoding while two additional bits perform specific and distinct functions (See Introduction of the Provisional Application). The first and second functions of bits 8 and 9 in addition to the fact that DC balancing will be used to transport audio information are important in considering the proposal. The elements of the Abstract in the Application of Mair et al. (i.e., Publication no. 2002/0186322 A1) are proposed in the Introduction of the provisional. In addition, the Principle of operation as well as in the section named "proposal" were considered by the examiner. Considering the fact that the elements of

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the abstract of Mair's Publication (2002/0186322 A1) are found in the proposal (which is the provisional application), it is clear to the examiner that one skilled in the art can and would look to the provisional application to derive the Abstract as well as to find the claimed limitations of the applicant.

The examiner wishes to note that while the applicant's provisional application contains all the part of a regular application, the proposal submitted by Mair in the provisional application is considered valid as well since to the examiner the requirements for the 35 U.S.C. 112 first paragraphs are present.

The rejection is repeated for the sake of completeness.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Mair et al. (US Patent Application Publication no. 2002/0186322 A1).

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Regarding claims 1, 12 and 13, Mair discloses the same method of transmitting auxiliary data in video encoding (See Abstract) comprising receiving first and second data (See [0042], lines 4-6), encoding the first data based on a state of at least one bit of the second data (See [0033], lines 7-19 and [0035, lines 7-16) , packaging the encoded first data and the second data into a single word (See [0042]), and communicating the single word (See [0043]).

As per claim 18, the limitations of this claim are met in the rejection of claims 1, 2 and 13 above.

As per claim 2, Mair further discloses the same method comprising DC balancing the first data (See [0021, lines 10-19).

As per claim 3, Mair further discloses the same method wherein the first data further comprises determining whether the first data should be inverted (See Mair [0038], lines 5-9).

As per claim 4, Mair further discloses the same method wherein encoding the first data further comparing a state of inversion of the first data to the state of the at least one bit of the second data (See [0038], lines 20-32).

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As per claims 5-6, Mair further discloses inversion according to a matching criteria (See [0038], lines 5-34).

As per claims 7-11, most of the limitations of these claims have been noted in the above rejection of claim 1. In addition, the intermediate value being the audio data is disclosed in Mair [0021 and 0041].

As per claims 14-17, most of the limitations of these claims have been noted in the above rejection of claims 13. In addition, the step of performing the different logic operations as claimed is met in fig. 3B and in [0038].

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mair et al. (US Patent Application Publication no. 2002/0186322 A1).

As per claims 19-21, most of the limitations of these claims have been noted in the above rejection of claims 1, 12 and 13.

It is noted that while Mair provides the encoding and decoding in figs. 3A, 3B and 5, it is silent about the enhanced and un-enhanced aspect of the coding/decoding process. However, from paragraphs [0041 to paragraph 0044] Mair discloses several encoding and decoding techniques wherein the encoding is performed with modulation, and the receiver/decoder receives the data without being encoded in [0044], and the receiver/decoder may send recovered auxiliary data to generate data path based on the accuracy of the auxiliary data. These steps are considered either equivalent or render the enhanced and un-enhanced encoding/decoding obvious to one skilled in the art since the purpose of using enhanced/or unenhanced decoder/encoder is to transmit the auxiliary data without prior knowledge of the capability of the video received receiving auxiliary data as suggested by Mair in [0044].

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S. Philippe whose telephone number is (571) 272-7336. The examiner can normally be reached on M-F (10:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dastouri Mehrdad can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gims S Philippe  
Primary Examiner  
Art Unit 2621

GSP

March 16, 2007